



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,000	02/26/2002	Paul M. Cosenza	12912-002001	4287

26161 7590 09/21/2004

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

SMITH, KIMBERLY S

ART UNIT PAPER NUMBER

3644

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,000

Applicant(s)

COSENZA, PAUL M.

Examiner

Kimberly S Smith

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/24/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on 08/24/04 is acknowledged.
2. Claims 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/24/04.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Luria et al., US Patent 5,381,557 (Luria).

Luria discloses a protection device comprising a set of protection elements (i.e. disclosed as being wearable around the limb(s) of the user) inherently having an elongate substrate having a first and second adhesive layer (reference column 4, line 56 for the disclosure of double sided tape). Kuo et al., US Patent 6,503,591 shows double-sided tape includes two opposite adhesive layers provided on two sides of a substrate (column 1, lines 17-20).

Art Unit: 3644

Regarding claims 7-9, Luria discloses the device as claimed. As can be seen in the figures, the protection element must be pre-configured for length and shape, as it would not be functional if not pre-configured to fit.

Regarding claim 10, Luria discloses the protection elements have the form of a roll (defined as something being rolled up in a cylinder, reference Figure 5).

Regarding claim 11, Luria discloses the protection element has the form of a sheet (defined as a portion of something that is think in comparison to its length and breadth, reference Figure 5).

Regarding claim 12, Luria discloses a shield portion (14a/15a) extending outwardly from a plane of the substrate relative to and generally above the second outer adhesive layer (as viewed in Figure 6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luria et al., US Patent 5,381,557 (Luria) in view of Kuo et al., US Patent 6,503,591 (Kuo).

Luria discloses the invention substantially as claimed including the use of double-sided tape. However, Luria does not positively state the use of an inner release sheet and an outer release sheet attached upon respective adhesive layers. Kuo discloses that it is known in the art

Art Unit: 3644

that two pieces of release paper are known to cover the adhesive layer of double-sided tape to protect them from contaminants and dust. It would have been obvious to one having ordinary skill in the art to use outer and inner release sheets prior to the assembly of Luria to prevent dust and contaminants from negatively affecting the adhesive ability of the disclosed adhesive.

7. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luria et al., US Patent 5,381,557 (Luria)

Luria can be read as disclosing the shield portion is an integral extension of the substrate (integral being defined as to form, coordinate or blend into a function or unified whole).

However, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to have the shield portion as an integral extension of the substrate, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Regarding claim 14, Luria discloses the shield portion being downwardly curved and outwardly extending (as seen in Figure 6).

Regarding claim 15, Luria discloses the shield portion being a protrusion from the second outer surface of the substrate (as viewed in Figure 6).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S Smith whose telephone number is 703-308-8515.

The examiner can normally be reached on Monday thru Friday 10:00-4:00.

Art Unit: 3644

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kss



TERI P. LUU
SUPERVISORY PRIMARY EXAMINER